



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,886	03/24/2004	Eric O. Bodnar	6783P054	6636

8791 7590 12/15/2005

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/808,886	BODNAR ET AL.	
	Examiner	Art Unit	
	Md S. Elahee	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 11 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter i.e., the message handler is part of the MMSC of claim 11 (lines 1, 2), the message handler is part of the third party originator of claim 13 (lines 1, 2), which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. However, the original claim 1 states a third party originator to send a notification/message to a recipient without the use of a multi-media messaging service center (MMSC) (lines 1-3). One of ordinary skill in the art would not be able to send a notification/message from a third party originator to a recipient **without the use of a MMSC** if the message handler is part of the MMSC and of the third party originator.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1, the phrase 'the responses' on page 2, line 4 lacks sufficient antecedent basis.

Claim Objections

5. Claim 10 is objected to because of the following informalities: regarding claim 10, acronym 'MMSC' used in the claim needs to be spelled out. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 7, 10, 11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ala-Laurila (U.S. Patent No. 6,246,871).

Regarding claim 1, Ala-Laurila teaches a short message service (SMS) [i.e., third party originator] to send a notification/message to a recipient without the use of a server 30 [i.e., multi-media messaging service center (MMSC)] (abstract; fig.1; col.2, lines 15-24, 60-67, col.4, lines 16-32).

Ala-Laurila further teaches a message database selector 32 [i.e., message handler] to manage the responses sent by the recipient to the server (fig.1; col.3, lines 17-30).

Regarding claims 7 and 16, Ala-Laurila teaches a message ID spoofer to select a message ID for the notification/message sent by the third party originator that will be handled by the MMSC (fig.1; col.3, lines 17-30, 61-67, col.4, lines 1-9). (Note; message ID spoofer is an inherent for the message database selector 32 [i.e., message handler])

Regarding claim 10, Ala-Laurila teaches a message handler to ensure that a response directed to a server 30 [i.e., MMSC] in response to a notification/message by a short message

Art Unit: 2645

service (SMS) [i.e., third party originator] to a recipient are managed without triggering error messages inherently in the MMSC (abstract; fig.1; col.2, lines 15-24, 60-67, col.3, lines 17-30, col.4, lines 16-32).

Regarding claim 11, Ala-Laurila teaches a message database selector 32 [i.e., message handler] is part of the server [i.e., MMSC] (fig.1).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

Art Unit: 2645

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ala-Laurila (U.S. Patent No. 6,246,871) in view of Chan et al. (U.S. Pub. No. 2004/0123144).

Regarding claims 2 and 12, Ala-Laurila does not specifically teach “a proxy server to redirect responses sent by the recipient to the MMSC”. Chan teaches a proxy server to redirect responses sent by the recipient to the MMSC (fig.4; page 6, paragraph 0062). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ala-Laurila to incorporate a proxy server to redirect responses sent by the recipient to the MMSC as taught by Chan. The motivation for the modification is to have doing so in order to act as an intermediate agent between user and back-end application.

12. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ala-Laurila et al. (U.S. Patent No. 6,246,871) in view of Middleton, III et al. (U.S. Patent No. 6,393,407).

Regarding claim 5, Ala-Laurila fails to teach “a dummy message inserter to insert a dummy message into the MMSC, such that the MMSC accepts the response sent by the recipient to the MMSC”. Middleton teaches a dummy message inserter to insert a dummy message into the MMSC, such that the MMSC accepts the response sent by the recipient to the MMSC (fig.2; col.5, lines 54-65). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ala-Laurila to incorporate a dummy message inserter to insert a dummy message into the MMSC, such that the MMSC accepts the response sent by the

recipient to the MMSC as taught by Middleton. The motivation for the modification is to provide the user an option to leave web page in the server.

Regarding claim 6, Ala-Laurila teaches that the responses are sent by the recipient to the MMSC (fig.1; col.3, lines 17-30). However, Ala-Laurila fails to teach “the responses sent by the recipient to the MMSC, as indicated by the dummy message inserter”. Middleton teaches the responses sent by the recipient to the server [i.e., MMSC], as indicated by the dummy message inserter (fig.2; col.5, lines 54-65). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ala-Laurila to incorporate the responses sent by the recipient to the MMSC, as indicated by the dummy message inserter as taught by Middleton. The motivation for the modification is to provide the user an option to leave web page in the server.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ala-Laurila (U.S. Patent No. 6,246,871) in view of Perkowski (U.S. Pub. No. 2002/0169687).

Regarding claim 15, Ala-Laurila fails to teach “a dummy message inserter to notify the MMSC that a notification/message has been sent directly to the recipient”. Perkowski teaches a dummy message inserter to notify the MMSC that a notification/message has been sent directly to the recipient (page16, paragraph 0160). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ala-Laurila to incorporate a dummy message inserter to notify the MMSC that a notification/message has been sent directly to the recipient as taught by Perkowski. The motivation for the modification is to track the status of messages.

Allowable Subject Matter

14. Claims 3, 4 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Silverman (U.S. Patent No. 6,226,668) teach Method and apparatus for web messaging.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/808,886

Page 8

Art Unit: 2645

M.E.

MD SHAFIUL ALAM ELAHEE

December 11, 2005



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600